



PTO/SB/33 (07-06)

Approved for use through xx/xx/200x. OMB 0651-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays an OMB control number.

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number (Optional)  
5490-000250/CPB

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Application Number  
10/769,741Filed  
January 30, 2004First Named Inventor  
Lakin, et al.Art Unit  
3732Examiner  
Candice C. StokesOn January 2, 2007

Signature

Typed or printed name Richard W. Warner / Christopher A. Eusebi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Attachment (5) pages

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 38,043 / 44,672.

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

Richard W. Warner / Christopher A. Eusebi

Typed or printed name

248 641-1600

Telephone number

January 2, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of one forms are submitted.



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/769,741  
Filing Date: January 30, 2004  
Applicant: Lakin, et al.  
Group Art Unit: 3732  
Examiner: Candice C. Stokes  
Title: METHOD AND APPARATUS FOR USE OF A METAL-METAL  
CONSTRAINED LINER  
Attorney Docket: 5490-000250/CPB

---

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**REMARKS/ARGUMENTS INCLUDED WITH A PRE-APPEAL BRIEF**  
**REQUEST FOR REVIEW**

Applicants respectfully submit that there are clear errors in the rejections set forth in the Office Action mailed July 26, 2006 and subsequent Advisory Action mailed October 31, 2006. Specifically, the combination of the cited art fails to set forth a prima facie rejection of the pending claims. Therefore, this Pre-Appeal Brief Request For Review is necessary and proper.

**The Pending Claims**

Claims 1-21 and 38-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cook et al. (U.S. Pat. No. 5,989,293) in view of Sullivan et al. (U.S. Publication No. 2003/0125810). Claims 1-17, 19-32 and 34-37 stand rejected as being unpatentable over Gray, III (U.S. Pat. No. 5,800,555) in view of Sullivan et al. (U.S. Publication No. 2003/0125810).

### Remarks and Arguments

Independent Claims 1, 22, 27 and 34 all include the limitation that the integral generally spherical bearing surface is a polished bearing surface. These independent claims further contain the limitation that the integral generally spherical bearing surface is configured to directly engage with an articulating surface of a femoral component. This is opposed to the support surfaces in each of the cited references, which simply support a bearing insert and are not structurally configured to directly engage an articulating surface of a femoral component. The Final Office Action's rejection of these claims based on the combinations of Cook in view of Sullivan or Gray in view of Sullivan is in clear error.

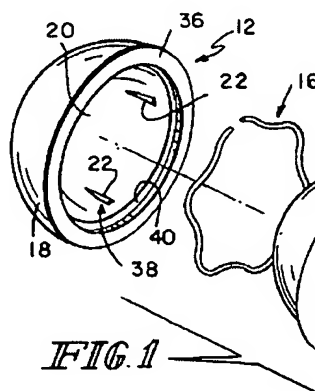
### Final Office Action Dated July 26, 2006

In characterizing Cook, et al. (U.S. Pat. No. 5,989,293), the Examiner states that the Cook reference teaches a first integral generally spherical concave bearing surface. The Examiner further states it would be obvious to combine this reference with Sullivan to have a machined surface of Cook be a polished metal surface. Applicants respectfully traverse this combination. Applicants note that while Cook et al. may teach a machined inside diameter, Cook does not teach an integral polished concave bearing surface configured to directly engage an articulating surface of a femoral component as is claimed. Cook merely teaches a conventional machined metal shell that receives a polymer bearing insert, where the polymer bearing insert is designed to directly engage a femoral component.

With respect to the cited Sullivan reference, Applicants note that the cited passage on hardness and smoothness is directed to a convex humeral articulating portion of a

prosthetic joint and not the claimed concave surface. Further, the figures of the Sullivan reference appear to disclose at least a two-piece glenoid component having a concave bearing surface. Figures 1 and 2 show a concave bearing surface formed of more than one material (see element 8). There is no teaching in the Sullivan reference of a concave prosthetic that can act both as a support of a second prosthetic and an articulating bearing surface. One simply would not be motivated to combine the references to provide a polished concave bearing surface with a locking mechanism configured to couple a second implant with a spherical bearing surface. This combination is simply missing from the references, as is any motivation to combine the references.

With respect to the rejections of Claims 1-17, 19-32 and 34-37 over Gray in view of Sullivan et al.), column 3, lines 27-30 of Gray states, "The inner surface 20 of acetabular cup 12 is provided with a plurality of anti-rotation lugs 22 which engage the outer surface 42 of the bearing liner 14 upon insertion of the bearing liner 14 into the acetabular cup 12." (emphasis added)



Applicants assert that the structure of the inner surface 20 of the cup 22 is not capable of performing as an articulating bearing surface as claimed because of the anti-rotation lugs 22. Further, Applicants assert there is simply no motivation in the Sullivan reference to

transform the non-articulating surface of either Cook or Gray into an articulating bearing surface. All of the references cited teach two-piece prosthetics having polymer bearing liners.

Claims 21 and 34 contain the limitation that the second prosthetic defines a generally capsule shaped cavity that allows for rotation and translation of the head. In rejecting these claims, the Examiner cites Figure 6 of the Gray reference. Applicants note that Figure 6 of the Gray reference discloses an acetabular cup with a constraining ring. This constraining ring, while allowing the rotation of the femoral head, prevents translation of the femoral head. As such, the rejection of these claims is improper.

#### Advisory Action

In the Advisory Action dated October 31, 2006, the Examiner has returned to the position that “machined” is analogous to “polished”. In doing so, the Examiner cited the definition of “machined” from dictionary.com. Applicants acknowledge that most prosthetics are machined into shapes as opposed to being “cast.” However, Applicants submit that this does not mean that a machined surface is “polished.” The Office’s attention is directed to search results from the dictionary.com site. In this regard, the term “polished” at dictionary.com is 1.) made smooth and glossy; 2.) naturally smooth and glossy; 3.) refined, cultured, or elegant.

Applicants respectfully assert that “machined” as known in the art is not polished, or a suggestion of polished.

Applicants submit that the Examiner has failed to meet the burden required in making a *prima facie* rejection under 35 U.S.C. § 103(a) inasmuch as all of the limitations

are not shown or suggested in either of the Cook, Gray or Sullivan references. Not only do the references not teach all of the claimed limitations, but one skilled in the art would not be motivated to combine the teachings of the Cook or Gray with the Sullivan reference to arrive at the claimed invention. In this regard, Applicants submit that there is no teaching within the references or general knowledge of those skilled in the art that would motivate one skilled in the art to combine the references.

Respectfully submitted,

Dated: July 2, 2007

By: Richard W. Warner  
Richard W. Warner, Reg. No. 38,043  
Christopher A. Eusebi, Reg. No. 44,672

HARNESS, DICKEY & PIERCE, P.L.C.  
P.O. Box 828  
Bloomfield Hills, Michigan 48303  
(248) 641-1600

CAE/smb